

REMARKS

In the Office Action dated September 29, 2003, claims 1 and 9-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Windel et al '463 in view of Gilham, Talmage '138 and Guenther et al. Claims 2-5, 12 and 13 were rejected over this combination further in view of Eckert (although various combinations of these five patents were applied against different claims, and therefore it is not seen why separate rejections were not made). Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Windel et al '846, Gilham, Guenther et al and Eckert, further in view of Windel et al '146. Claims 7 and 8 were rejected over the same combination relied upon to reject claim 6, further in view of Cordery et al.

These rejections are respectfully traversed for the following reasons. Independent apparatus claim 1 and independent method claim 9 both explicitly refer to the use of a security module containing a security module data processing unit. The term "security module" has a well understood meaning to those of ordinary skill in the field of postage meter design and operation, and refers to a highly protected component wherein security-related data processing takes place. Not only is the data used by the security module protected electronically, such as by encryption, message authentication codes and the like, but also the security module is physically protected, typically by encasement in extremely strong potting material, or even metal.

Because of the necessity to physically protect the security module, it must be of a relatively small size, and therefore the data processing and memory capacity of the components within the security module are also limited, or at least they cannot be arbitrarily expanded.

The present inventors have recognized that these limitations associated with the security module cause it to be a bottleneck for the fast processing of mail. This is in part because of recently implemented guidelines by the U.S.P.S. and other governmental postal authorities requiring that the franking imprint that is printed on each piece of mail have a unique identifier for that piece of mail, containing information specified by the postal authority. The relevant regulations for the U.S.P.S. are known as the Information Based Indicia Program (IBIP) as specified in the publication dated June 13, 1996 that was submitted as Reference AR with the Information Disclosure Statement filed January 29, 2001. Because these U.S.P.S. requirements, and comparable requirements in other countries, require security-related data to be printed in encoded form on each franking imprint, this means a calculation of the security information and/or the appropriate encoding must be undertaken for each item of mail, before the franking imprint for that item of mail can be compiled, since the security information must be contained in the franking imprint. Moreover, the security information is of the type which must be handled by the security module. This means that the data processor in the security module, despite the aforementioned limitations thereof in terms of processing capacity and memory capacity, must perform a new calculation for every piece of mail to be processed by the postage meter containing the security module. Because of the size limitations imposed by the necessity of physically encapsulating the security module, the processing and/or memory capacity thereof cannot simply be expanded in order to accommodate these relatively recent requirements.

The present inventors have recognized that this bottleneck can be alleviated by taking certain processing tasks, which are not specifically security-related, out of the security module and performing those non-security-related processing tasks in a

separate processor. The processing capacity of the security module can then be devoted exclusively to security-related processing. The majority of the franking imprint can be compiled outside of the security module, and the security module need only calculate the necessary security information for inclusion in the franking imprint, and then communicate that information to the separate data processor for inclusion in the compilation of the franking imprint.

The method and apparatus disclosed and claimed in the present application, therefore, is a solution to a problem that arises because of the use of a security module in a postage meter, and because of the limitations that are associated with such a security module. In the rejection, the Examiner characterized the Windel et al '163 and Gilham references as disclosing a security module, however, Applicants are unable to find any disclosure whatsoever of a security module in either of those references, as that term is commonly employed in the field of postage meter design and operation. Those references disclose a main processor, which may be divided into a host processor and a CPU, however, neither of those devices is a security module. Although in the older Windel et al '463 and Gilham systems the processors disclosed therein may perform security-related processing tasks, this does not make either of those processors a security module, as that term is commonly understood. The processors in the Windel et al '463 and Gilham references, therefore, do not exhibit the limitations that are associated with a security module as to processing and memory capacity, and therefore neither of those references presents the problem to which the method and apparatus of the present application are directed, and therefore neither of those references can provide any guidance towards solving that problem.

The Examiner relied on the Talmage reference as disclosing a separate data processing unit that compiles the printing data, and Applicants acknowledge that in the Talmage reference different processors are employed for different purposes, however, again none of the processors therein is a security module. Among the four references cited by the Examiner with regard to claims 1 and 9-11, only the Guenther et al reference discloses a true security module, namely the component designated PSM (for Postal Security Module) and provided with Reference 86. That reference, however, is an example of a device exhibiting the problems to which the present method and apparatus are a solution, and the Guenther et al reference does not provide any guidance toward that solution.

The Examiner relied on the Guenther et al reference as disclosing a smartcard that can be inserted in a card reader of the meter disclosed in Guenther et al. This is correct, however, the use of just such a smartcard has nothing to do with dividing the processing tasks of the various components in Guenther et al, and particularly does not have anything to do with dividing those processing tasks in the manner set forth in independent claims 1 and 9 of the present application.

As argued in the Appeal Brief, which resulted in reopening of prosecution, the subject matter disclosed and claims in the present application is not "merely" a division of processing tasks. Before the processing tasks could even be divided as set forth in the claims of the present application, the inventors had to first recognize that the aforementioned problem associated with a security module could be solved by relieving the security module of certain processing tasks, and then the inventors had to determine which processing tasks conventionally performed by the data processor in the security module could be performed by some other data processor. Given the fact that U.S.P.S. regulations as well as the governmental postage

regulations in other countries now require a security-related calculation before the franking imprint can even be compiled for a piece of mail, references such as the Gilham reference, which issued as a patent before such regulations even existed, cannot provide any guidance to those of ordinary skill in the art seeking to solve problems associated with the subsequent development of postal security modules and the subsequent passage of the aforementioned regulations. These recently developed innovations and requirements have contributed to creating the aforementioned problem, and references developed before those innovations even existed cannot provide any guidance to those of ordinary skill in the art to solving problems that did not exist at that time.

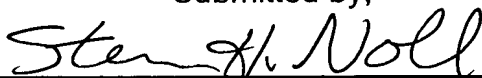
Applicants therefore respectfully submit that the Examiner, after reading the present disclosure and claims has simply gone backward into the art and lifted a number of different teachings from different patents, without giving consideration as to why or how the method and apparatus disclosed and claimed in the present application was developed. The Examiner has not provided the evidence and substantiation that are necessary to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) in the manner required by numerous decisions of the United States Court of Appeals for the Federal Circuit. Simply lifting various teachings from various references, none of which exhibits the problem solved by the claims of the present application, and making a backward-looking argument for obviousness, does not satisfy the requirements of 35 U.S.C. §103(a).

In view of the above arguments regarding the Examiner's primary combination of references, Applicants submit it is not necessary to individually discuss each of the further references that were relied upon for rejecting different ones of the dependent claims. Since the independent claims are patentable over the teachings

of the primary group of references relied upon by the Examiner, even if that primary group of references were modified in accordance with the teachings of other secondary references, the subject matter of the dependent claims still would not result, since each of those dependent claims embodies either the subject matter of independent claim 1 or independent claim 9 therein.

All claims of the application are therefore submitted to be in condition for allowance, and early reconsideration of the application is respectfully requested.

Submitted by,



(Reg. 28,982)

SCHIFF, HARDIN & WAITE

CUSTOMER NO. 26574

Patent Department

6600 Sears Tower

233 South Wacker Drive

Chicago, Illinois 60606

Telephone: 312/258-5790

Attorneys for Applicants.

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